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EXAMINER

FISH, JAMIESON W

ART UNIT PAPER NUMBER

2617

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,049

Applicant(s)

YAMAMURO ET AL.

Examiner

Jamieson W. Fish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18, 19 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, 19 and 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7-14-2005 have been fully considered but they are not persuasive. The applicant argues with respect to claims **18-19, 29** and **32** that Shintani does not disclose or suggest recording viewing information on a recording medium (See Remarks item C). As discussed in previous office action and in the rejection below the number of points in Shintani is viewing information. The number points accumulated is viewing information because it implicitly describes how much content has been viewed.
2. Applicant's arguments with respect to claim **1-16** and **29-35** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. Claim **35** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim **35** recites "wherein the identifier includes viewing information indicating whether or not the corresponding program contents have been viewed by a user of the recording medium." In the specification (See Pg 17 lines 5-11 and Pg 23 lines 5-12) the identifier is merely a code that identifies program contents and can be used to indicate viewing information, but does not include viewing

information. To expedite the prosecution of this application claim 35 has been examined with "includes" being replaced by "indicates."

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims **1, 8, and 29-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Nemirofsky et al. (US 5,880,769).
5. Regarding claim **1**, Nemirofsky et al. receiver comprising: a program acceptor for accepting program contents, and program information having a program identifier to identify program contents; a display unit for displaying the program contents; and a viewing information recorder for recording, on a removable recording medium, viewing information having the program identifier to identity the program contents, when the program contents are displayed on the display unit (See Item 18 of previous office action and Nemirofsky et al Col. 7 lines 48-52).
6. Regarding claims **8**, claim **8** is a method claim related to the apparatus of claim 1. Therefore, claims **8** is analyzed and rejected according to claim 1.
7. Regarding claims **29-31**, claims **29-31** differ from original claims 29-31 rejected under Nemirofsky (US 5,594,493) in that there is an identifier for identifying program contents. Nemirofsky et al (US 5,880,769), which incorporates Nemirofsky (US 5,594,493), teaches an identifier for identifying program contents (See Col. 7 lines 48-52). Thus, claims **29-31** are anticipated by Nemirofsky et al (US 5,880,769).

8. Claims **18-19, 29, 32** are rejected under 35 U.S.C. 102(b) as being anticipated by Shintani (EP 0 921 696).

9. Regarding claim **18**, Shintani teaches a viewing information processor (See Fig. 1 Microprocessor 8 and Paragraph 16) for reading, from a removable recording medium on which viewing information having program identifiers for identifying program contents are recorded, the recorded viewing information (See Fig. 1 Smart Card 10 and Paragraph 22, 44 Smart card stores the ID of the Commercial program (identifiers for identifying program contents) and the number of points (viewing information)), and processing the viewing information, said viewing information comprising: a viewing information acquisition unit for reading the viewing information (See Fig. 2 S9 and Paragraphs 24, 28 and 29 Viewing information is number of points); a service information holding unit for holding service contents in association with a provision condition that is a condition to provide a service specified by the service contents (See Paragraphs 28 and 29. Service is discounted pay broadcasting. Provisional condition is number of points needed for discount pay for broadcast); a service contents decision unit for deciding the service contents, by applying the provision condition held by said service information holding unit to the viewing information obtained by said viewing information acquisition unit (See Fig. 2 S13 Paragraphs 24 and 30. Decision is made as to if user has enough points to get pay broadcasting for a discount. Points are obtained by viewing information); and a service contents output unit for outputting the service contents decided by said service contents decision unit (See Paragraphs 30 and 31 Discounted Pay Broadcasting is output if there are enough points).

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10. Regarding claim **19**, Shintani teaches the viewing information processor further comprising a viewing information deletion unit for deleting the viewing information recorded on the recording medium, when the service contents output unit outputs the service contents decided by service contents unit (See Paragraph 29, 44 Points are subtracted).

11. Regarding claim **29**, Shintani teaches a transmitter/receiver system comprising: a transmitter for transmitting program contents and an identifier for identifying program contents (See Fig. 2 S2, S3, Paragraph 13, Paragraph 22-25, Receiver receives a program and a commercial ID, transmitter is inherent); a receiver for receiving the program contents and the identifier transmitted from said transmitter, and recording the identifier on a removable recording medium (See Fig. 1, Fig. 2, S2, S3, Paragraph 13, Paragraph 22-25 ID and points are recorded on the smart card); and an information terminal for reading the right identifier recorded on the removable recording medium, and performing a process corresponding to the read identifier (See Paragraph 44-50 Contents of smart card including commercial ID and points associated with ID are read at a terminal. Terminal then analyzes the IDs and number of points rewarded. Viewer receives a discount if enough points have been earned); wherein said receiver comprises: a program acceptor for accepting the program contents and the identifier (See Fig. 1 Tuner 2 and Paragraph 13); a display unit for displaying the program contents (See Fig. 1 Display 7A and Paragraph 14); and a viewing information recorder for recording, on the removable recording medium, the identifier corresponding to the

program when the program contents are displayed on the display unit (See Fig. 1 Smart Card 10 and Paragraph 22-24).

12. Regarding claim **32**, Shintani teaches wherein said information terminal comprises: an identifier acquisition unit for reading the identifier recorded on the removable recording medium (See Fig. 2 S9 and Paragraphs 24, 25, 28 and 29 Points rewarded are right identifier); a service information holding unit for holding service contents in association with a provision condition that is a condition to provide a service specified by the service contents (See Paragraphs 28-29, and 44. Service is discounted pay broadcasting or merchandise. Provisional condition is number of points needed for discount pay for broadcast); a service contents decision unit for deciding the service contents, by applying the provision condition held by said service information holding unit to the identifier obtained by said identifier acquisition unit (See Fig. 2 S13 Paragraphs 24 and 30. Decision is made as to if user has enough points to get pay broadcasting for a discount. Points are obtained by viewing information); and a service contents output unit outputting the service contents decided by the service contents decision unit (See Paragraphs 30-31, 44 Pay Broadcasting or merchandise is received at a discount if there are enough points).

13. Regarding claim **35**, Shintani teaches where the identifier indicates viewing information indicating whether or not the corresponding program contents have been viewed by a user of the recording medium (Paragraph 36-37).

Claim Rejections - 35 USC § 103

14. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiya et al. (EP 0 892 554) in view of Nemirofsky et al. (US 5,880,769)

15. Regarding claim 1, Sumiya teaches a receiver comprising: a program acceptor for accepting program contents, and program information having a program identifier to identify program contents (See Fig. 2, Broadcast Reception Unit 201 Fig. 4 Program ID Field 410, Col. 14 lines 2-13, Col. 15 lines 40-58, Col. 16 lines 1-2); display unit for displaying the program contents (See Fig. 38 Display Unit 3804 and Col. 42 lines 49-58, Col. 43 lines 1-5); and viewing information recorder, on a removable recording medium, for recording viewing information having the program identifier to identify the program contents, in response to program contents being displayed on the display unit (See Fig. 38 Viewing History Hold Unit 3808, Fig. 41, Fig. 42, 45, Fig. 102, Col. 42 lines 49-58, Col. 43 lines 1-18, Col. 79 lines 35-43 Viewing history is are stored on a removable memory). Sumiya differs from the claimed invention in that viewing information (viewing history) is not necessarily stored on the removable recording medium when the viewing information is displayed on the display unit. However, systems that record viewing information to a removable recording medium while program contents are being displayed are well known in the art as taught by Nemirofsky et al (See Col. 1 lines 18-67, Col. 2 lines 1-9). Thus, in view of Nemirofsky et al, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sumiya so that viewing information was recorded a removable recording while program contents

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are being displayed on the screen to achieve real time interactivity (See Nemirofsky Col. 1 lines 48-50).

16. Regarding claim 2, Sumiya modified with Nemirofsky et al. teaches the receiver further comprising: a display attribute acquisition unit for obtaining a display attribute that is an attribute by which the program contents are displayed (See Sumiya Fig. 2 Display Control Unit 203 Col. 17 lines 30-46); wherein the viewing information has the display attribute and the program identifier (See Sumiya Fig. 3, Fig. 4 Col. 13 lines 45-58, Col. 14 lines 1-35).

17. Regarding claim 3, Sumiya modified with Nemirofsky et al. teaches wherein the display attribute is a position where the program contents are displayed (See Sumiya Fig. 3 Image Data Field and Col. 13 lines 45-57 Moving picture data would include position where program contents are displayed).

18. Regarding claim 4, Sumiya modified with Nemirofsky et al. teaches wherein the viewing information further includes a number of viewing times, which is a number of times a user has viewed the program contents (See Sumiya Fig. 42 Frequency and Col. 44 lines 44-51).

19. Regarding claim 5, Sumiya modified with Nemirofsky et al. teaches an input acceptor for accepting a user input (See Sumiya Fig. 38 Input Unit 3805 and Col. 44 lines 7-11); wherein, when program contents are displayed on said display unit based on of the user input accepted by said input acceptor, said viewing information recorder is operable to record viewing information on the removable recording medium (See Sumiya Col. 44 lines 12-44).

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20. Regarding claim **6**, Sumiya modified with Nemirofsky et al. teaches wherein, when the input acceptor accepts the user input for a predetermined period of time, the viewing information recorder is operable to record the viewing information on the removable recording medium (See Sumiya Col. 44 lines 7-44 When the user selects a program (pushes a button for a predetermined amount of time) the program information is added to viewer history).

21. Regarding claim **7**, Sumiya modified with Nemirofsky et al. teaches wherein: said input acceptor is operable to accept an input of information related to the program content (See Sumiya Fig. 38 Input Unit 3805 Col. 44 lines 7-44 Input selecting program is an input related to the program); and when said input acceptor accepts the related information, said viewing information recorder is operable to record viewing information on the removable recording medium (See Sumiya Col. 44 lines 32-43 When user selects program, attributes are saved).

22. Regarding claims **8-14**, claims 8-14 are method claims related to the apparatus of claims 1-7, respectively. Therefore claims **8-14** are analyzed and rejected according to claims 1-7.

23. Regarding claim **15**, claim 15 is a computer-readable program medium on which a program making a computer execute the method of claim 8 is stored. Sumiya modified with Nemirofsky et al. teaches wherein the method is executed by a program on a computer-readable medium (See Sumiya Fig. 2 Control Unit 212).

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24. Regarding claim **16**, Sumiya modified with Nemirofsky et al. teaches a removable recording medium on which viewing information is recorded by the viewing information method of claim 8 (See Sumiya Fig. 102, Col. 79 lines 35-43).

25. Claims **33-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al (US 5,880,769) in view of Roberts (US 5,987,525).

26. Regarding claims **33-34**, claims **33-34** differ from original claims **33-34** rejected under Nemirofsky (US 5,594,493) in view of Roberts in that there is an identifier for identifying program contents. Nemirofsky et al (US 5,880,769), which incorporates Nemirofsky (US 5,594,493), teaches an identifier for identifying program contents (See Col. 7 lines 48-52). Thus, claims **33-34** are unpatentable over Nemirofsky et al (US 5,880,769) in view of Roberts.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 9-29-2005


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